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REMARKS

The present amendment replies to the Non-Final Office Action dated November 22, 2004. Claims 1, 3-7, 9-12, and 14-20 are currently pending in the application. New claims 16-20 have been added. No new matter has been added with the amendment.

In the non-final office action, Examiner Bugg rejected claims 1-15 on various grounds. The Applicant responds to each ground for rejection as subsequently recited herein and respectfully requests reconsideration and further examination of the present application under 37 CFR § 1.112.

A. Claims 1-15 were rejected under 35 U.S.C. § 112, first paragraph as failing to comply with the enablement requirement.

The Applicant has thoroughly considered Examiner Bugg's remarks considering the patentability of claims 1-15. The Examiner's rejection is respectfully traversed.

As the Examiner is well aware, when basing a rejection on the failure of the applicant's disclosure to meet the enablement provisions of the first paragraph of 35 U.S.C. 112, the examiner must establish on the record that he or she has a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to *undue experimentation* (See MPEP 2106.1). The Examiner has failed to advance a reasonable basis for questioning the adequacy of the Applicant's disclosure. Regardless, the Applicant responds to each of the Examiner's unfounded assertions that the specification is not enabling

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The Examiner would like to know why the configuration of the electronic module is necessary and for what purpose the module is being configured. The present specification shows this purpose starting on page 7, line 26. Specifically, the present specification states at page 7, line 27 that a new configuration is required if the electronic module 114 or telematics module 120 is removed from one vehicle and installed in a different vehicle. Additionally, at page 8, line 5 the present specification states that the pre-defined configuration process is required to ensure the proper function of the electronic module with the vehicle into which the module is installed. The specification further states that an electronic module 114 or telematics module 120 that is moved from a source vehicle to a target vehicle must be reconfigured to provide the proper functions to the target vehicle. Thus the present specification shows the purpose for which the module is being configured and why it is necessary.

It is clear to one skilled in the pertinent art that an electronic module must be properly configured for the vehicle into which it is installed. Additionally, it is clear to one skilled in the pertinent art that for the electronic module to be properly configured a configuration process is required to produce the proper configuration. One skilled in the pertinent art would be able to develop a configuration process for modifying the configuration of an electronic module without undue experimentation. Therefore, the examiner has not provided a reasonable basis for questioning the adequacy of the disclosure to enable a person of ordinary skill in the art to make and use the claimed invention without resorting to undue experimentation.

The examiner would like to know what the configuration process entails. Configuration processes are well known to those with skill in the art. Further, the present specification is quite clear as to what the configuration process entails. Specifically, the present specification states at page 8, line 9 that the pre-defined configuration process is coded to modify certain parameters of the particular electronic module 114 or telematics module 120. Examples of changes that might be made by the predefined configuration process, follow in the present specification, and include modifying phone number and email address to ensure proper functioning of the phone, modifying the vehicle security

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features enabled by the theft deterrent control module, and modifying an associated parameter within the climate control module corresponding to the installed climate control system. The present specification further states at page 8, line 20 that the configuration process enables custom features the vehicle owner has purchased, by modifying parameters associated with those features.

The examiner would like to know what exactly do the electronic module parameters represent. The present specification provides examples of electronic module parameters as vehicle-specific settings of particular variables within the electronic module. One such example shows the proper functioning of the powertrain control module within a vehicle requires setting the parameter indicating transmission type to correspond to the transmission type installed in the vehicle (See page 8 lines 11-21).

Additionally, the examiner would also like to know what exactly the information in the configuration table is used for. The present specification states that the configuration table instructs the configuration process as to the proper parameter settings for the module 114 or telematics module 120 in a particular vehicle 110 and that alternately, the configuration table instructs the electronic module 114 or telematics module 120 to contact a call center 180 (see page 8 lines 22-29). It is well known to one skilled in the pertinent art what information can be included in a configuration table for achieving the parameter modifications discussed.

The examiner alleges that claims 3, 9 and 14 are in conflict with claims 1, 7, and 12 in that the second VIN is stored in the vehicle, and then the electronic module. The examiner would like to know if it is being stored in both locations, or being transferred from one location to the other. The applicants have amended claims 3, 9, and 14 to more clearly claim that the VIN stored in the vehicle is being stored to the electronic module, thereby replacing the first vehicle identification number with the second vehicle identification number in the electronic module as supported by the specification at page 10, line 2 where it states the VIN obtained *from* the control module (the second vehicle identification number) is written to and stored by the electronic module's non-volatile

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memory. Applicants respectfully submit that the amended claims obviate this point of rejection.

Applicants respectfully submit that the subject matter of the claims is described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. Therefore, the Applicants respectfully request that the rejection of claims 1-15 under 35 U.S.C. § 112, first paragraph be withdrawn.

B. Claims 1-3, 5-9 and 11-14 were rejected under 35 U.S.C § 102(e) as being anticipated by U.S. Patent Publication No. US 2003/0188303 A1 to Barman et al.

The Applicants have thoroughly considered Examiner Bugg's remarks considering the patentability of claims 1-3, 5-9, and 11-14 over U.S. Patent Publication No. 2003/0188303 A1 to Barman (Barman). The Applicants have also thoroughly read the Barman Publication. The Examiner's rejection is traversed.

In order for this 102(e) rejection to stand, each and every element of the claimed invention must be disclosed in at least as great detail as claimed. Claims 1, 7, and 12 have been amended to include the limitation that configuring the electronic module occurs based on a mismatch detected between the first vehicle identification number (VIN) and the second vehicle identification number. This limitation finds support in the specification at page 9, line 25 where it states if the VINs match, as when a defective module is repaired and then re-installed in the same vehicle, no configuration is required. In section 15 Barman requires verifying that the identification number from a connected controller matches a first identification number from the apparatus before the software of the engine controller is upgraded. Therefore Barman does not disclose each and every element of amended claims 1, 7, and 12.

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Further, section 45 of Barman teaches away from the invention. Barman states that the apparatus is preferably configured so that it can be used only with one specific engine controller. This is accomplished by comparing a serial number stored in the apparatus to one stored in the engine controller. Barman teaches that if this comparison fails then the apparatus does not continue and no modification is made to the software in the connected engine controller. In contrast, claims 1, 7, and 12 of the invention, as amended, require that the comparison fail before configuring the electronic module. Specifically, the system is configured so that it can be used with any electronic module thereby allowing the electronic module to be moved between vehicles. Barman specifically states that VIN verification prevents moving a engine controller to a different vehicle. Therefore Barman does not disclose each and every element of amended claims 1, 7, and 12. Claims 2, 8, and 13 have been cancelled obviating the rejection of these claims.

Claims 3, 9, and 14 incorporate the subject matter of cancelled claims 2, 8, and 13. Claims 3, 9, and 14 as amended disclose that "copying the second vehicle identification number determined from the vehicle to the memory of the electronic module thereby replacing the first vehicle identification number with the second vehicle identification number in the electronic module" Barman does not disclose such a limitation. Instead Barman discloses comparing the VIN from the memory 30B of the reprogrammer to the VIN from the engine controller where the reprogrammer is an apparatus designed to install a software upgrade to the engine controller. The VIN in Barman is used to determine whether the reprogrammer was used in a particular vehicle and to prevent it from being used in a different vehicle. In Barman the method or apparatus makes no changes to the VIN in store in either the reprogrammer or the engine controller. In the instant invention the VIN is used to determine if the module is new to the vehicle and if so to make the necessary changes to the module to conform the module to the vehicle. The VIN from the vehicle is copied to the electronic module to complete the process. The VIN disclosed in the instant invention is not equivalent to the VIN from the memory 30B of the reprogrammer disclosed in Barman which may be changed to

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match the particular engine controller to which the software upgrade is applied. Therefore Barman does not disclose each and every element of amended claims 3, 9, and 14.

Claims 5 and 6 depend from claim 1. Claims 5 and 6 are allowable for at least the same reasons as those for claim 1.

Claim 11 depends from claim 7. Claim 11 is allowable for at least the same reasons as claim 7.

Applicants respectfully submit that the rejection of claims 1, 7, and 12 under 35 U.S.C. § 102(e) is obviated by the amendment of the claims. Therefore, the Applicants respectfully request that the rejection of claims 1-3, 5-9 and 11-14 under 35 U.S.C. § 102(e) be withdrawn.

C. Claims 4, 10, and 15 were rejected under 35 USC § 103(a) as unpatentable over U.S. Patent Publication No. US 2003/0188303 A1, to Barman et al.

The Applicants have thoroughly considered Examiner Bugg's remarks considering the patentability of claims 4, 10, and 15 over U.S. Patent Publication No. 2003/0188303 A1 to Barman (Barman). The Applicants have also thoroughly read Barman. The Examiner's rejection is traversed.

Claims 4, 10, and 15 depend from amended independent claims 1, 7, or 12, respectively and contain all of the elements of the respective independent claim. Therefore claims 4, 10, and 15 are allowable at least for the reasons as those for amended claims 1, 7, or 12. Applicants respectfully submit that the rejection of claim 4, 10, and 15 under 35 U.S.C. § 103(a) be withdrawn.

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D. Claims 16-20 are allowable over the prior art

New claims 16-20 depend directly or indirectly from its respective independent claim and, therefore, includes all of the claim limitations contained in the independent claim. For at least this reason, new claims 16-20 are allowable over the prior art.

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SUMMARY

Examiner Bugg's rejection of claims 1, 3-7, 9-12, and 14-15 is respectfully traversed based on the above discussion. The Applicants respectfully submit that claims 1, 3-7, 9-12, and 14-20 fully satisfy the requirements of 35 U.S.C. §§ 102, 103 and 112. In view of the foregoing amendments and remarks, favorable consideration and early passage to allowance of the present application is respectfully requested.

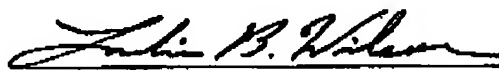
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Respectfully submitted,
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